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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,399	09/10/2003	Hironori Ohnishi	018995-736	2239
21839	7590	12/13/2004	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			GILLIAM, BARBARA LEE	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/658,399	OHNISHI, HIRONORI	
	<b>Examiner</b> Barbara L. Gilliam	<b>Art Unit</b> 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 10 September 2003.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-16 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/10/2003.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claims***

2. Claims 1-16 are present.
3. Claims 11-14 further limit the anionic surfactant without requiring the choice of the anionic surfactant over the amphotolytic surfactant.
4. Claims 15-16 further limit the amphotolytic surfactant without requiring the choice of the amphotolytic surfactant over the anionic surfactant.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawauchi et al. (EP 1 275 498 A2).
  - a. The positive working lithographic printing plate precursor of Kawauchi et al. comprises a lower layer containing a water insoluble and alkali-soluble resin, and upper heat-sensitive layer containing a water-insoluble and alkali soluble resin and an

infrared absorbing dye (abstract). After imagewise exposure to active light, preferably a light source having an emission wavelength in the region from near infrared to infrared, the plate is developed with a non-silicate alkali developer ([0112]-[0116]). Examples of the alkali agent in the developer include sodium carbonate, potassium carbonate, ammonium carbonate, ammonium hydrogencarbonate and ammonium borate ([0123]-[124]) which meet the present limitations for the at least one alkali metal salt and the salt of an ammonium cation. Various surfactants, including anionic, cationic and amphoteric surfactants can be used for the purpose of accelerating or inhibiting development, dispersing the development scum, or enhancing the ink-receptivity of the image area of the lithographic printing plate ([0128]). The anionic and amphoteric surfactants meet the present limitations for the anionic and amphoteric surfactants.

b. Therefore it would have been *prima facie* obvious to one of ordinary skill in the art to expose the positive working plate of Kawauchi et al. with a light source having an emission wavelength in the region from near infrared to infrared and to develop the plate with a non-silicate developer comprising an anionic surfactant or amphoteric surfactant with reasonable expectation of dispersing the development scum.

7. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being obvious over Nagase (US 2004/0002019 A1).

a. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the

reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

b. Nagase teach a method of preparing a lithographic printing plate wherein the plate is exposed and developed with an alkali developer containing a sulfonate group-containing anionic surfactant (abstract; [0303]). The plate may have a double-layer structure comprising a heat-sensitive layer disposed in a position near to the surface and a lower layer disposed on the side near the support and containing an alkali-soluble resin and an alkali soluble compound. Both or one of the layers can contain the infrared absorption dye and the alkali-soluble resin ([0273]). This double layer structure, wherein the lower layer comprises one of the alkali soluble compounds and the upper layer comprises the infrared absorption dye and one of the alkali soluble resin, meets the present limitations for the respective lower layer and upper layer. The alkali developer comprises an alkali agent such as ammonium borate ([0042]) and the

anionic surfactant in a concentration of 0.01 to 10 g/L ([0051]). The sulfonate group-containing anionic surfactant of the general formula in paragraph [0047] is identical to the anionic surfactant of the present claims.

c. Therefore it would have been *prima facie* obvious to one of ordinary skill in the art to make, expose to infrared radiation and develop a printing plate comprising on a support, a lower layer comprising an alkali-soluble resin, an upper layer comprising an infrared absorbing compound and an alkali-soluble resin, wherein the developer is an aqueous alkaline developer comprising an alkali agent and a sulfonate group-containing anionic surfactant with an expectation of inhibiting the generation of processing scum based on the teachings of Nagase.

### ***Conclusion***

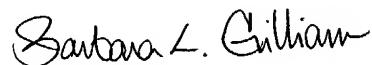
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. In US 6,472,119 B1 and EP 1 023 994 A1, Verschueren et al. teach a heat mode sensitive imaging element comprising a first layer and a top layer wherein the top layer is unpenetrable or insoluble for an alkaline developer.
- b. In US 2004/0101780 A1, Maemoto teach a planographic printing plate precursor. Maemoto was filed after the present application.
- c. In US 2003/0157434 A1, Oda et al. teach a positive planographic printing plate.
- d. US 2003/0129532 A1 is the US equivalent to EP 1 275 498 A2.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Barbara L. Gilliam  
Primary Examiner  
Art Unit 1752

bg  
December 8, 2004